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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/836,369	10/20/97	SCHMIDT	V RSG 8379 US

MM42/0927  
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EXAMINER

HIRSHFELD, A

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 09/27/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/836,369**

Applicant(s)  
**Schmidt**

Examiner  
**Andrew Hirshfeld**

Group Art Unit  
**2859**



☒ Responsive to communication(s) filed on Jul 19, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1 and 3 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1 and 3 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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**DETAILED ACTION**

***Continued Prosecution Application***

1. The request filed on July 1, 1999 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/836,369 is acceptable and a CPA has been established. An action on the CPA follows.

***Specification***

2. The substitute specification filed June 16, 1999 has been entered.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollander et al. (5,368,392).

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Hollander et al. '392 teaches a device and method for outlining an energy zone on a surface whose temperature is to be measured. The device includes a pistol grip radiometer in combination with a laser aiming device. In the embodiment illustrated in figures 5 and 10, the laser device includes a means for simultaneously emitting a plurality of more than two laser beams towards the surface to outline the energy zone. In figure 10, the beams are divergent. As stated in col. 6, lines 49-51, individual lasers can be used or laser splitting devices can be used to split a single laser beam. The temperature measurement device can be positioned on the central axis of the plurality of laser beams, downstream of the beam splitter.

Hollander et al. '392 does not teach the sighting arrangement having a diffractive optical system (particularly that formed by a holographic element).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hollander et al. '392 by replacing the beam splitter thereof with a diffractive optical system, such as one formed by a holographic element, since such a diffractive optical system and the beam splitter of Hollander et al. '392 are equivalent and alternative devices for creating an image from a beam of light. One having

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ordinary skill in the art at the time the invention was made would recognize that any conventional beam splitting device could suffice in the device of Hollander et al. '392.

Please note that the declaration of William Menchine, filed June 16, 1999, shows that diffraction gratings for generating a circle were known in the art prior to applicant's invention.

5. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over German patent document 32 13 955 in view of British patent document 2 203 537.

German patent document 32 13 955 teaches a device for measuring temperature wherein a detector includes means for capturing infrared energy and a sighting arrangement for splitting an incident beam of light into first and second beams 13' and 13''. The beams 13' and 13'' mark the diameter of a measurement spot on an object to be measured by producing diametrically opposed visible marks.

German patent document 32 13 955 does not teach outlining the measurement spot; and the sighting arrangement having a diffractive optical system (particularly one formed by a holographic element).

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British patent document 2 203 537 teaches the combination of a radiometer and a sighting device wherein a masking element is placed in front of a visible light source so that light from the source will outline (by means of a circle) the periphery of an energy zone on a target surface.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify German patent document 32 13 955 by replacing the beam splitter thereof with a system that creates a circle to outline the measurement spot, since British patent document teaches that a circular outline of an energy zone can provide valuable information concerning the zone, such as the exact position of the zone. One having ordinary skill in the art would recognize, based upon the combined teachings of German patent document 32 13 955 and British patent document 2 203 537, that laser beams arranged in a circular configuration around an energy zone would provide a more accurate indication of the energy zone than merely two diametrically opposed beams. Therefore, the proposed combination would improve the device of German patent document 32 13 955 by enabling it to provide a more accurate indication of the energy zone.

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Also, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a diffractive optical system (such as that formed by a holographic element) to generate the circular outline, since all beam splitters are alternative and equivalent devices for creating a plurality of beams from a single beam, and it is apparent that any beam splitter could function in the device of German patent document 32 13 955.

#### ***Inventorship***

6. The petition to correct the inventorship of this nonprovisional application under 37 CFR 1.48(a) is deficient because the declarations filed June 16, 1999 are defective for the following reasons:

a. The declarations do not properly refer to the specification to which they pertain. Please note that the declarations state that the specification was filed on May 13, 1997 as Application No. 08/836,369. This date is not proper, and should be replaced by October 20, 1997.

b. The citation to the PCT priority document is not proper, since the application number of this document is different from that in the declarations.

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c. The declaration signed by William Menchine should be amended so that the signature block lists Mr. Menchine as "Inventor 2", rather than inventor 1.

A new oath or declaration identifying this application by application number and filing date is required.

***Response to Amendment***

7. The declarations filed under 37 CFR 1.131 have been considered but are ineffective to overcome the 5,368,392 reference, since this reference is a statutory bar under 35 U.S.C. 102(b) and thus cannot be overcome by an affidavit or declaration under 37 CFR 1.131.

8. With regard to the papers filed June 25, 1999 in response to the DECISION ON REQUEST FOR RETROACTIVE LICENSE UNDER 37 CFR 5.25 mailed March 9, 1999, the application will be forwarded to Group 3640 (Special Laws and Administration) for review.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Andrew Hirshfeld whose telephone number is (703) 305-6619.



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Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0956.



Andrew Hirshfeld  
Primary Examiner  
Art Unit 2859  
September 22, 1999